

filed on May 28, 1997. Hence, no copies were required. This matter was resolved in a phone conference with the Examiner. It was indicated that the references would be considered and made of record in a subsequent Office Action. Applicants attorney thanks the Examiner for his assistance in resolving this matter.

The drawings were objected to under 37 C.F.R. 1.83(a) because they failed to show element number 81 as described in the specification. In response thereto, enclosed please find a modified sheet 3/10 in which element 81 has been added, in red, to Figure 3. Formal drawings incorporating this correction will be provided upon receipt of a Notice of Allowance for this application.

The Examiner has apparently rejected Claim 12 under 35 U.S.C. 112, second paragraph. The Examiner has stated that the limitation "a lower facing panel attachment member adapted to be frictionally attached to the bottom portion of the other facing panels" does not have sufficient antecedent basis in the specification (emphasis in original). The Examiner has stated that since the application "does not recite or explain this broad limitation in the specification, the examiner would considered of any two non-lubricated elements are to be frictionally attached." (sic) Applicant respectfully traverses this rejection. The limitation recited in Claim 12 is discussed beginning at line 14 of page 9 through line 8 of page 10. Further, it is unclear to the Applicants' attorney as to what is meant by there being "insufficient antecedent basis for this limitation in the specification." Clarification by the Examiner is respectfully requested. In any event, it is respectfully submitted that this language in the claims is fully supported by the specification and drawings as originally filed.

Claims 1-26 and 42-56 are pending in the application; all claims stand rejected.

Claims 1-18 and 42-55 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Waalkes, U.S. Patent No. 6,098,358 (the Waalkes '358 patent). The Examiner has stated that,

with regards to Claims 1-14, Waalkes '358 discloses a knock-down portable partition system 1, comprising vertical posts 6, apertures 45, lock members 12, panel frames 2, connectors 5 between frame with panels (sic), cover panels 4, a top cap 150 with retaining clip 151, outer arms 152, inner edges 153, a bent back edge 157, a downwardly extending arm 158, a base cover 50, utility troughs 30, 31, communication lines 30 and power lines 28. Specifically the Examiner has cited Figures 2, 3, 9, 26, 36, 37 and Column 6, lines 10-33, 43-48, Column 11, lines 5-17 and Column 12, lines 2-9 of the Waalkes patent. With regards to claims 15-18 and 42-55, the Examiner cites two Figures, 37 and 41. It is respectfully submitted that, based on the portion of the specification and figures of Waalkes '358 cited by the Examiner, this patent is not citeable as a reference under 35 U.S.C. § 102(e).

It is noted that U.S. Patent No. 6,098,358 is a continuation-in-part of application serial number 08/856,995 which is now U.S. Patent No. 5,899,035 (Waalkes '035 patent). The parent application has a filing date of May 15, 1997 while the continuation-in-part application has a filing date of April 15, 1998. It is noted that the present application is a continuation of Application Serial No. 08/864,138 filed on May 28, 1997. Therefore, the filing date of the instant application precedes the filing date of the Waalkes '358 patent, with respect to those portions of the specification which were newly added in the continuation-in-part application.

With respect to the portions of the specification and figures of the Waalkes '358 patent cited by the Examiner, in comparing its disclosure with the original disclosure in the Waalkes '035 patent, at least those portions of column 11, lines 5-17, modified Figures 3, 9 and 26 (with respect to Claims 1-14), and Figure 41 (with respect to Claims 15-18 and 42-55) were newly added in the continuation-in-part application. Therefore, those portions of the Waalkes '358 patent are not citeable as prior art against Applicant's original disclosure, which has not been modified since the original filing date of May 28, 1997. Therefore, it is respectfully submitted

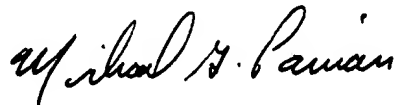
that the Waalkes '358 patent is not citeable as a reference. Furthermore, the original disclosure of the Waalkes '035 patent does not show each and every element of Claims 1-18 and 42-55. Specifically, the top cap 150 with retaining clip 151, outer arms 152, inner edges 153, bent back edge 157 and downwardly extending arm 158 were added to the continuation-in-part application having a filing date of April 15, 1998. Therefore, the Waalkes '358 patent cited by the Examiner is not citeable as a reference under 35 U.S.C. § 102(e). Moreover, since the Waalkes '035 patent does not show each and every element of the claimed invention, neither of these patents is citeable as a reference under 35 U.S.C. § 102. *See In Re: Paulsen*, 30 F.3d. 1475, 1478-1479, 31 U.S.P.Q. 2d. 1671, 1673 (Fed. Cir. 1994).

The rejection to the remaining claims 19-26 and 56 are based on 35 U.S.C. § 103(a) as being unpatentable over the Waalkes '358 patent in view of either Nickens or Goodman. It is respectfully submitted that, since the primary patent cited by the Examiner is not citable as a reference under 35 U.S.C. § 102, it cannot be used as a reference under 35 U.S.C. § 103(a). In addition, similar to the Waalkes '358 patent, it is noted that the patent to Goodman, et al. cited by the Examiner, U.S. Patent No. 6,000,180, is a continuation-in-part application of U.S. Patent 5,802,789. The continuation-in-part patent has a filing date of January 9, 1998, which again is after the effective filing date of Applicant's invention of May 28, 1997. Specifically, the entire specification of Goodman was changed from the original parent application Serial No. 08/767,817 filed December 17, 1996. Therefore, since the entire specification of the Goodman '180 patent was newly filed on January 9, 1998, it does not have the benefit of the December 17, 1996 filing date of the parent application and is not citable as a reference under 35 U.S.C. § 103(a).

Based on the foregoing, it is respectfully submitted that the application is allowable over the prior art of record, in that two of the three references cited by the Examiner in the 35 U.S.C.

§ 102 and 103 rejections are not properly citeable as references, especially the main patent to Waalkes, et al. 6,098,358. Therefore, since there are no references of record, including those previously submitted by the Applicant's in the Information Disclosure Statement filed August 31, 2000, the application, as amended, is allowable over the prior art. Thus, a favorable action allowing the application is requested. If the Examiner is of the opinion that a telephone conference would lead to an early resolution of any outstanding issues, he is invited to call Applicant's representative at the number listed below.

Respectfully submitted,



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Dated: 3/19/01

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